



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/315,621

05/20/1999

AJAY RAJKUMAR

5

6743

7590 12/16/2008
HARNESS, DICKEY & PIERCE, PLC
PO BOX 8910
Reston, VA 20195

EXAMINER

DESAI, RACHNA SINGH

ART UNIT	PAPER NUMBER
----------	--------------

2176

MAIL DATE	DELIVERY MODE
-----------	---------------

12/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AJAY RAJKUMAR

Appeal 2008-1494
Application 09/315,621
Technology Center 2100

Decided: December 16, 2008

Before JEAN R. HOMERE, JAY P. LUCAS and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

According to Appellant, the invention relates generally to the field of audio files, and more particularly, to linking an audio file (Spec. 1, ll. 5-6).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method for linking an audio file to a database, the method comprising the steps of:

obtaining a client identifier during a client contact;

accessing a financial record in the database using the client identifier;

recording at least a portion of the client contact as the audio file;

storing the audio file on a recording media; and

linking the audio file to the financial record.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Akagiri	US 5,491,481	Feb. 13, 1996
Dockes	US 5,974,004	Oct. 26, 1999
Maes	US 6,016,476	Jan. 18, 2000
Kelly	US 6,047,292	Apr. 4, 2000
DeMartin	US 6,226,672 B1	May 1, 2001
Mogenis	US 6,466,258 B1	Oct. 15, 2002

Claims 1, 2, 13-17, and 19 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes.

Claims 6, 8, 9, 11, 18, and 20 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes and Dockes.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes, Dockes and DeMartin.

Claims 5 and 10 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes, and Kelly.

Claims 7 and 12 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes and Akagiri.

We affirm.

II. ISSUES

The issues are whether Appellant has shown that the Examiner erred in finding that claims 1, 2, 13-17, and 19 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis and Maes. In particular, the issues turn on:

A. whether the combination of Mogenis and Maes discloses “accessing a financial record in the database using the client identifier” (claim 1); and

B. whether it would have been obvious for one of ordinary skill in the art to combine the teachings of Mogenis and Maes.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Mogenis

1. Mogenis discloses a security center 14, which includes a controller 38 that receives data from customer premises 12 by way of signal path 30 and is connected to a data source 210 that includes such information as floor plans of, and resources available at, the customer premise 12 (col. 4, l. 66 to col. 5, l. 4; Fig. 2).
2. The security center 14 also includes a recording or archiving database or memory 212 which automatically records audio information at the center 14 for later use, wherein playback arrangement 214 is coupled to memory 212 (col. 5, ll. 7-13; Fig. 2).
3. Additional data about the Customer Premises, such as floor plans, may be stored (col. 7, ll. 32-33).

Maes

4. Maes discloses a memory for storing financial and personal information of a user (Abstract).

IV. PRINCIPLES OF LAW

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read

into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 127 S. Ct. at 1742. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.*

In *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007), the Federal Circuit recognized that “[a]n obviousness [determination] is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)).

V. ANALYSIS

A. All Claimed Elements are Taught by Mogenis and Maes

Appellant does not provide separate arguments with respect to the rejection of claims 1, 2, 13-17, and 19. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that “Mogenis cannot disclose or suggest ‘accessing a financial record in the database using the client identifier’” because “Mogenis does not disclose or suggest a financial record of any kind” and “Mogenis is further silent in specifying how the Recording/Archival means

212 may be accessed” (App. Br. 10). The Examiner finds that Mogenis in view of Maes discloses such limitation (Ans. 3). Thus, an issue we address on appeal is whether the combination of Mogenis and Maes discloses “accessing a financial record in the database using the client identifier” (claim 1).

We generally agree with the Examiner’s finding that the combined teaching of Mogenis and Maes discloses the claimed elements on appeal beginning at page 3 of the Answer, and including the Examiner’s corresponding responsive arguments beginning at page 11 of the Answer.

Mogenis discloses storing information concerning a customer premise in a data record 210 (FF 1 and 3), wherein the stored data concerning the customer premise is pulled up for use during a call. An audio file recorded during a call is stored on a recording media 212 that is linked to the customer premise (FF 2). An artisan would have understood that, in order to access such data record during the call as disclosed by Mogenis, an identifier associated with the customer premise is used to pull up the data record of the customer premise, because an artisan is also a person of ordinary creativity, not an automaton. *See KSR*, 127 S. Ct. at 1742.

Furthermore, Maes discloses that a stored data record may be a financial data record (FF 4). One of ordinary skill in the art would have found it obvious to also use an identifier to access financial data records, as well as other data records, from the combined teaching of Mogenis and

Maes. We thus agree with the Examiner that the combined teaching of Mogenis and Maes discloses or at the least strong suggests “accessing a financial record in the database using the client identifier” (claim 1).

Though Appellant argues that “Mogenis does not disclose or suggest a financial record of any kind” (App. Br. 10), the Appellant appears to be arguing that Mogenis alone fails to disclose the claim limitation. However, the Examiner has rejected the claims based on the combination of Mogenis and Maes, and nonobviousness cannot be shown by attacking the references individually. As discussed above, Maes discloses that a stored data record may be a financial data record (FF 4).

As to Appellant’s argument that “Mogenis is further silent in specifying how the Recording/Archival means 212 may be accessed,” such argument is not commensurate with the claimed invention. That is, the claims do not require that the Recording/Archival means 212 be accessed. The claims merely recite accessing the “financial record... using the client identifier” and “linking the audio file to the financial record” (claim 1).

As discussed above, Mogenis discloses accessing a data record 210 associated with a specified client (FF 1 and 3), and that the combined teaching of Mogenis and Maes discloses or at the least strongly suggests accessing a specified financial record using a client identifier.

Mogenis discloses that an audio file is recorded during client contact is stored on the Recording/Archival means 212 that is linked to the customer premise (FF 2). Though claim 1 recites “linking the audio file to the

financial record,” Appellant simply does not place any limitation on what “linking” is to be, to represent, or to mean, other than that data is the audio file is linked to the financial record. We thus give the term its ordinary meaning of “associating with,” and find that an artisan would have understood that such audio file stored on the Recording/Archival means 212 associated with the customer premise is linked to the data record associated with the customer premise. Accordingly, we conclude that the combined teaching of Mogenis and Maes discloses or at the least suggests accessing the “financial record... using the client identifier” and “linking the audio file to the financial record” (claim 1).

A. It Would Have Been Obvious to Combine Mogenis and Maes

Appellant also argues that “one skilled in the art would not combine the references of Mogenis and Maes” (App. Br. 11). However, the Examiner finds that “Mogenis’ system could be applied to any type of record without interfering with the purpose of associating and storing an audio file to a record,” such as the record of Maes (Ans. 5). Thus, another issue we address on appeal is whether it would have been obvious for one of ordinary skill in the art to combine Mogenis and Maes.

Mogenis discloses accessing a data record (FF 1-3). Maes discloses that a data record could include a financial record (FF 4). We agree with the Examiner’s finding that it would have been obvious to combine the teachings of Mogenis and Maes, to include accessing a financial record. The combination yields an expected result.

Appellant has provided no evidence that incorporating Mogenis' data record access to Maes' financial records was "uniquely challenging or difficult for one of ordinary skill in the art," *See Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d at 1162, nor has Appellant presented evidence that this incorporation yielded more than expected results. Rather, Appellant's invention is simply an arrangement of the well-known teaching of accessing a data record with the known teaching of financial records. *See KSR*, 127 S. Ct. at 1742. Therefore, it is our view that a person of ordinary skill would have been able to fit the teachings of the cited references together like pieces of a puzzle.

Accordingly, we find that claim 1 would have been obvious over the teachings of Mogenis in view of Maes. Thus, we conclude that the Appellant has not shown that the Examiner erred in rejecting claim 1, and claims 2, 13-17, and 19 falling with claim 1, under 35 U.S.C. § 103(a).

Appellant does not provide separate arguments with respect to the rejection of dependent claims 3-12, 18, 20, depending from independent claims 1, 16, and 19, respectively. As discussed above, we find no deficiency regarding the combined teachings of Mogenis and Maes in the rejection of claims 1, 16, and 19. Thus, we conclude that the Appellant has not shown that the Examiner erred in rejecting claim 6, 8, 9, 11, 18, and 20 over Mogenis, Maes, and Dockes, in rejecting claims 3 and 4 over Mogenis,

Maes, Dockes, and DeMartin, in rejecting claims 5 and 10 over Mogenis, Maes, and Kelly, and in rejecting claims 7 and 12 over Mogenis, Maes, and Akagari, under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

(1) Appellant has not shown that the Examiner erred in finding that claims 1, 2, 13-17, and 19 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes.

(2) Appellant has not shown that the Examiner erred in finding that claims 6, 8, 9, 11, 18, and 20 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes and Dockes.

(3) Appellant has not shown that the Examiner erred in finding that claims 3 and 4 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes, Dockes and DeMartin.

(4) Appellant has not shown that the Examiner erred in finding that claims 5 and 10 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes, and Kelly.

(5) Appellant has not shown that the Examiner erred in finding that claims 7 and 12 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Mogenis in view of Maes and Akagiri.

(6) Claims 1-20 are not patentable.

Appeal 2008-1494
Application 09/315,621

DECISION

We affirm the Examiner's rejection of claims 1-20 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

pgc

HARNESS, DICKEY & PIERCE, PLC
PO BOX 8910
Reston VA 20195